

REMARKS

In the Office action mailed August 21, 2003, the Examiner rejected claims 13-16 and 18 as being obvious over Akatsuka (U.S. Pat. No. 5,437,450) in view of Meredith (U.S. Pat. No. 5,108,735). The Examiner rejected claim 17 as being obvious over Akatsuka in view of Meredith as applied to the aforementioned claims, and further in view of Kobayashi (U.S. Pat. No. 4,682,504) and Turner (U.S. Pat. No. 5,575,473). The Examiner removed the objection to claim 7 and indicated that claims 1-3, 5-9, 11-12 and 19-21 are allowed. The applicants appreciate the removal of the objection and the indication of allowable subject matter.

The applicants respectfully assert that the Examiner has failed to establish a prima facie case of obviousness with respect to claim 13. As will be shown below, no suggestion or motivation exists, either in the references or in the knowledge generally available to one of ordinary skill in the art, to combine Akatsuka with Meredith. Furthermore, assuming arguendo that Akatsuka can be properly combined with Meredith, the combined references fail to teach or to suggest all of the limitations required by claim 13.

As for a lack of motivation to combine Akatsuka with Meredith, the Board's opinion of December 23, 2002 is instructive on this point. When considering the appropriateness of the Examiner's rejection of claim 1 as being obvious over Akatsuka in view of Hogan, the Board indicated that they "fail[ed] to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to pick and choose the values from ranges disclosed in Akatsuka '450 which would be necessary in order to meet the terms of the claim." See Board's opinion page 10. The Board went on to state "[f]rom our perspective, the only suggestion for doing so resides in the luxury afforded one who first viewed the appellants' disclosure which, of course, is not a proper basis for a rejection under Section 103."

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In the Office action, the Examiner indicates that "in view of Meredith it would have been obvious to modify the shaft of Akatsuka to have a kick point above the center point of the shaft in order to provide a shaft for a club which produces a lower angle of trajectory for a player who tends to hit a ball high." Nevertheless, for the

combination to read on applicants' claim 13, one of ordinary skill in the art would be required to pick and choose a butt end diameter from the lower 20% of the ranges disclosed in Akatsuka. Consideration of the teachings of Meredith, which will be discussed in more detail below, does not overcome the problems with Akatsuka regarding the issue of the selection of values from the ranges. Accordingly, Akatsuka cannot be properly combined with Meredith to read on claim 13; however, even if the Examiner argues that Akatsuka and Meredith can be combined, when combined they fail to read on claim 13.

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Claim 13 recites "said butt section diameter displacing a kick point above a center point of the golf club shaft." Neither Akatsuka nor Meredith teaches or suggests the butt section diameter displacing the kick point above a center point of the shaft. Meredith only discloses changing the length of the butt section and/or the tip section to change the kick point of the shaft. First, Meredith only makes mention of a kick point above a center point of the shaft in passing when discussing the prior art. Additionally, Meredith fails to suggest that the butt section diameter displaces the kick point above a center point of the golf club shaft. In column 4 of Meredith, two example shafts are disclosed and the diameter of the butt section remains the same in each example. Furthermore, Meredith teaches away from a configuration where the butt section diameter displaces the kick point above the center point of the golf club shaft. In column 4, Meredith states that "it will be appreciated that the length and gradual rate of taper of the tapering section ... enables the kick point ... to be changed." (Emphasis added) No mention is made of the diameter of the butt section. Finally, in the BACKGROUND OF THE INVENTION section, Meredith discusses problems associated with changing the diameter of portions of the shaft.

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The teachings of Akatsuka fail to remedy the problems associated with Meredith's failure to suggest the butt section diameter displacing the kick point. Akatsuka makes no mention of a kick point. Akatsuka makes no mention of a kick point. Accordingly, a proper combination of Akatsuka and Meredith fails to teach or suggest "said butt section diameter displacing a kick point above a center point of the golf club shaft," and therefore the Examiner has failed to establish a prima facie case

for obviousness for this reason as well.

As shown above, the Examiner improperly combined Akatsuka with Meredith. Furthermore, the combination of the two references still fails to read upon claim 13. Since the remainder of the rejected claims depend from claim 13, it is submitted that these claims are in condition for allowance.

All formal and informal matters having been considered, it is respectfully submitted that the pending claims are in condition for allowance. Notice to that effect is earnestly solicited. If any questions remain, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

FAY, SHARPE, FAGAN,
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A handwritten signature in black ink, appearing to read 'Scott A. McCollister', with a long horizontal line extending to the right.

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